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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,702	08/07/2001	Fumitake Yodo		1747

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EXAMINER
FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,702	Applicant(s) Fumitake Yodo
	Examiner Andrew J. Fischer	Art Unit 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Feb 10, 2003* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *8 and 9* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *8 and 9* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. *09/600,509* .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (Paper No. 10). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Accordingly, Applicant's after final amendment filed on December 26, 2002 (Paper No. 7) under 37 CFR 1.116 has now been entered. Claims 8 and 9 remain pending.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP §2181. Correction of the following is required:

a. The "means for carrying out an accounting processing" as recited in claim 8.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

4. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

a. In claim 8, it remains unclear as what is the corresponding structure which makes up the "means for carrying out an accounting processing . . . ." Applicant is respectfully requested to specifically point out in the specification and drawings (including the element numbers within the drawings) the elements which make up the corresponding structure.

b. In claim 9, it remains unclear as what is the corresponding structure which makes up the "means for carrying out an other accounting processing . . . ." Applicant is again respectfully requested to specifically point out in the specification and drawings (including the element numbers within the drawings) the elements which make up the corresponding structure.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another

> who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

6. Claims 8 and 9, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson, Jr. (U.S. 5,857,020) ("Peterson"). Peterson discloses an accounting system having accounting center (16) and a terminal device (70, 98, and 86). The terminal device comprising: a first memory (within card 88, e.g memory 91); a second memory (within medium 70, e.g. 79); a controller (86 and 94 within 86); the controller updates the attributes of the distributed information to an unavailable state (e.g. when the expiration time expires, the desired content again becomes unavailable); the controller updates the accounting points stored in the first memory based upon the distributed information (the change in points is a function of the cost of the content accessed); when accounting points are updated correctly; the controller updates attributes of the distributed information from an unavailable state to the available state (i.e. the user can access the desired information and the charge for that access is deducted); and a second controller (modem). The accounting center comprises means for carrying out an account processing (updating a user's account such as purchasing more points, inquiring into the number of points available, or receiving points for returned items, etc.) based upon the accounting points transmitted from the terminal device.

7. Functional recitation(s) using the word "for" (e.g. "for updating the accounting point information" as recited in claim 8) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed

invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If Applicant intends to give the phrase more patentable weight, the Examiner suggests removing "for" from the claims where intended use is not desired.

8. Claims 8 and 9, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(a) as being anticipated by Peterson. See the analysis above.

9. For due process purposes, the Examiner again notes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustom meanings. The Examiner notes three reasons to support his position. First, after receiving express notice of the Examiner's position that lexicography was *not* invoked,[1] Applicant elected *not* to point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b).[2] Second and also as noted in the Previous Office Action, it is again the Examiner's factual determination that not only has Applicant failed to point to definitional statements in his specification or prosecution history, Applicant has also failed to point to a term or terms in a claim with which to draw in those

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[1] See the initial Office Action mailed April 23, 2002, Paper No. 4, Paragraph No. 8 (hereinafter "the Initial Office Action").

[2] See the Examiner's previous Office Action mailed September 20, 2002, Paper No. 6, Paragraph No. 10 (hereinafter "the Previous Office Action")

statements.[3] Finally and also as noted in the Previous Office Action, Applicant has declined the Examiner's express invitation[4] to be their own lexicographer.[5] Therefore, except as noted under 35 U.S.C. §112 6th paragraph below, the heavy presumption in favor of the ordinary and accustom meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997),[6] and the Examiner continues to rely heavily and extensively on this interpretation.[7] See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) ("Because the patentee has not chosen

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[3] "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

[4] See again the Initial Office Action, Paragraph No. 8.

[5] The Examiner's request on this matter was reasonable on at least two separate and independent grounds: first, the Examiner's request was simply an express request for clarification of how *Applicants* intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements was reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, May 4, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed March 16, 2003).

[6] See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

[7] See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]"

to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning . . . .") (Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

35 U.S.C. 112 6th paragraph

Means Phrase #1

Invocation

10. It is the Examiner's position that the phrase "means for carrying out an accounting processing based on the accounting points transmitted from the terminal device " ("Means Phrase #1") is an attempt by Applicant to invoke 35 U.S.C. 112 6th paragraph in claim 1.

Invocation Step 1:

a. First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶* ("*Guidelines*")[8], and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d. 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),[9] Applicant's use of "means for" in claim 1 creates a rebuttable presumption that tends to invoke 35

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[8] Federal Register Vol 65, No 120, June 21, 2000.

[9] See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580,1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

U.S.C. 112 6th paragraph. If the word "means" appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which §112 6th paragraph applies. *Id.* Since "means for" is recited in Means Phrase #1, this step is clearly met.

Invocation - Step 2:

b. Second, in accordance with MPEP §2181, the *Guidelines*, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner's position that Applicant recites a corresponding function to the means—"carrying out an accounting processing [sic] based on the accounting points transmitted from the terminal device."

The Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). In this case because nothing in the written description, drawings, or code listings suggests that the patentee intended anything other than the unambiguous claim language, the function as found in the Means Phrase #1 will have its ordinary meaning. See Paragraph No. 9 above.

Invocation - Step 3:

c. Third, in accordance with MPEP §2181, the *Guidelines*, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, "the focus remains on whether the claim ... recites sufficiently definite structure." *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the "carrying out an accounting processing" can not be entirely performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner's position that Means Phrase #1 invokes 35 U.S.C. 112 6th paragraph.

Corresponding Structure, Material, or Acts

11. In accordance with MPEP §2181, the Guidelines (section "II") and *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.* 248 F.3d 1303, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001), "[t]he next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the written description is 'corresponding' to the claimed means under 35 U.S.C. 112 6th paragraph only if the structure is clearly linked by the written description . . . ." *Id.*

a. With this in mind, "disclosure of structure corresponding to a means-plus-function limitation may be implicit in the written description *if it would have been clear to those skilled in the art* what structure must perform the function recited in the means-plus-function limitation." *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) (emphasis in original).

In our case, the specification does not directly disclose or clearly link the corresponding structure in Means Phrase #1. Applicant's argue that "the accounting processing performed in the accounting center is shown in Fig. 11 and described in pages 39-40 of the present application, for example."[10]

b. First, Figure 11 is a flow chart and does not disclose any corresponding structure. Second, while pages 39 and 40 describe the accounting center, the recitation fails to clearly link or associate what is the corresponding structure. "If a patentee fails to disclose an adequate

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[10] See Applicant's "Remarks" in Paper No. 7, December 26, 2002, page 5, 4th paragraph.

corresponding structure in the specification, the patentee may fail to satisfy the bargain embodied in the statutory quid pro quo of section 112, paragraph six." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1215, 64 USPQ2d 1812, 1828 (Fed. Cir. 2002) (citations omitted).[11]

Because Applicant is claiming a system, the corresponding structure may or may not include the following because all the following are needed to perform the claimed function: a connection network (e.g. 18 in Peterson), a credit card authorization system since or way of receiving funds), and a center modem or controller. Alternatively, the corresponding structure may be just the CPU, memory, and the connecting modem.

12. The Examiner will next apply the above reasoning to all claimed phrases that potentially invoke 35 U.S.C. 112 6th paragraph. Citations and authorities will be omitted for clarity.

Means Phrase #2

13. It is the Examiner's position that the "means for carrying out an other accounting processing based on the request" ("Means for Phrase #2") does invoke 35 U.S.C. 112 6th paragraph.

a. Means for Phrase #2 meets Invocation Step 1 because "means for" is recited.

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[11] "Failure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2." *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)).

b. Means for Phrase #2 meets Invocation Step 2 because the phrase recites the function of "carrying out an other accounting processing . . . ." This function will have its ordinary and plain meaning.

c. Means for Phrase #2 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "carrying out an other accounting processing . . . ."

d. However, the specification again fails to directly disclose or clearly link the corresponding structure so that one of ordinary skill in the art can determine what structural elements make up precisely Means Phrase #2.

Response to Arguments

14. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. As noted above, while Applicant has stated the claims are definite, Applicant has not specifically pointed to the corresponding structural elements that make up the means for phrases.

15. Applicant's other arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner acknowledges and thanks Applicant for his "Remarks" (Paper No. 7) traversing the Examiner's positions on various points. If Applicant disagrees with *any* additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,[12] the Examiner respectfully requests Applicant *in his next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

AJF
May 4, 2003

AJ Fischer 5/4/03
ANDREW J. FISCHER
PATENT EXAMINER

[12] E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.